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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,164	06/25/2001	Ryuji Ishiguro	209466US6PCT	9239

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EXAMINER

AL HASHEMI, SANA A

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,164

Applicant(s)

ISHIGURO ET AL.

Examiner

Sana Al-Hashemi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Status: 1- 3, and 19-21 are rejected.

Applicant's arguments filed 4/16/04 have been fully considered but they are not persuasive.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/2/2003 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1- 3, and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiser et al (US Patent No. 6,330,675).

1. Regarding Claims 1, 2, and 3, Wiser discloses a control apparatus for control data for managing one or more contents data in accordance with using condition information

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corresponding to the content data, said using condition information is indicative of usage rules of the content data (see column 3, lines 45-55, Wiser¹) said apparatus comprising (see column 3, lines 43-59, Wiser):

means for receiving said using condition information, said using condition information being described in a first format (see column 3, lines 36-42, Wiser);

means for converting said format of said using condition information (see Fig. 2, 214, column 4, lines 34-37, Wiser), into a second format, said second format is being different from the first format(see column 3, lines 60-67, Wiser); and

means for transmitting the second using condition information described in the second format (see column 3, 4, lines 55-67, 1-8, respectively, Wiser).

2. Regarding Claims 19, 20, and 21, Wiser discloses a data processing apparatus for managing content data in a accordance with a using condition information corresponding to the content data, said using condition information is indicative of usage rule of the content data, said data processing apparatus comprising:

means for receiving said using condition information, said using condition information being described in a first format (see column 3, lines 36-42, Wiser); and

means for converting said first format of said using condition information into a second format said second format being different from the first format (see column 5, lines 35-3-43, Wiser)

wherein the using condition information includes at least one item comprising an item name and a value corresponding to the item name and the using condition information described in the second format is substantially equal to the item name and

¹ Examiner interprets digital audio file as a content data, use condition as an authorization for copying or

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the second using condition information is substantially equal in meaning to the first using condition information described in the first format (see column 6, lines 6-24, Wiser).

Response to Amendment

Applicant argues, Wiser fails to disclose or suggest “ means for converting a first format of the using condition information into a second format of the using condition information, the second format being different from the first format.”

Examiner disagrees. Referring to column 3, 8, lines 45-55, 52-65, respectively, Wiser discloses the method of converting the specific digital file requested or purchased by the user from encrypted which is the first format to a decrypted at the user end which is the second format using the using condition information as defined by the applicant on page 7, second paragraph, where the using condition may include (pay for copy). Examiner believes the prior art still reads on the claimed invention, since both the claimed subject matter and the prior art teaches the method of changing format for purchased digital file and protecting these digital files.

Other Prior Art Made of Record

1. Wiser et al. (US Patent No. 6,330,675) discloses a system and method for secure transfer of digital data to a local recordable storage medium.
2. Rhoads et al. (US Patent No. 6,442,285) discloses controlling operation of a device using a re-configurable watermark detector.

downloading files.

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3. Van Zoest et al. (US Patent No. 6,496,802) discloses system and a method for providing access to electronic works.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to: Sana Al-Hashemi whose telephone number is (703) 305-4881. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436. Any response to this office action should be mailed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231. Or telefax at phone number (703) 872-9306. For formal or draft communications, please label "PROPOSED" or "DRAFT". Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th Floor Receptionist, Arlington, Virginia. 22202.

Sana Al-Hashemi
Patent Examiner
Technology Center 2100
January 9, 2004



**UYEN LE
PRIMARY EXAMINER**